



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097088.394	06/01/98	BEAMAN	Y0993-028AB

MM51/0601

DANIEL P MORRIS  
INTELLECTUAL PROPERTY LAW DEPARTMENT  
IBM CORPORATION  
P O BOX 218  
YORKTOWN HEIGHTS NY 10598

EXAMINER
NGUYEN, V

ART UNIT	PAPER NUMBER
2858	

DATE MAILED: 06/01/99 #5

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/088,394

Applicant(s)  
Beaman et al

Examiner  
VINH P. NGUYEN

Group Art Unit  
2858



☒ Responsive to communication(s) filed on Jun 1, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire no month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 6-19 and 22-58 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 6-19 and 22-58 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2858

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 6-19 and 22-24, drawn to an electronic device probe for probing an electronic device, classified in class 324, subclass 765.
  - II. Claims 25-28,40-53,55-58, drawn to apparatus and method for testing an electronic device, classified in class 324, subclass 754.
2. III. Claims 29-39, drawn to a method, classified in class 29, subclass 842.
3. The inventions are distinct, each from the other because:
4. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (M.E.P.. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because protuberance of the elongated conductors are bonded to the surface of the contact locations on the first transformer. The subcombination has separate utility such as its intended purpose.
5. Inventions I & II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (M.E.P.. § 806.04, M.E.P.. § 808.01). In the instant case, the inventions of groups I & II are related to structure of a probing device for testing an electronic meanwhile the invention of group III is related to a method for making a probe device.

Art Unit: 2858

It is noted that the probe device in the inventions I & II can be made by different methods other than the method of group III.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their divergent subject matter and the search for group I is not necessary for group II, therefore the restriction for examination purposes as indicated is proper.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R 1.143).

8. A telephone call was made to the office of Mr. Morris on May 26, 1999 to request an oral election to the above restriction requirement, but did not result in an election being made.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R 1.48(b) and by the fee required under 37 C.F.R 1.17(I).


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINH P. NGUYEN whose telephone number is (703) 305-4914.

Application/Control Number: 09/088394

Page 4

Art Unit: 2858

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4900.

  
VINH P. NGUYEN  
PRIMARY EXAMINER  
ART UNIT 2858

05/26/99